IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants:	Jay S. Walker, James Jorasch, Magdalena Mik
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Title:	ELECTRONIC AMUSEMENT DEVICE AND METHOD FOR ENHANCED SLOT MACHINE PLAY

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Group Art Unit:	3714
Examiner:	Leiva, Frank M.

APPEAL BRIEF

BOARD OF PATENT APPEALS
AND INTERFERENCES

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Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed December 8, 2006 (Part of Paper No./Mail Date 20061129), rejecting claims **50-77**. This Appeal Brief is filed subsequent to a Notice of Appeal filed June 8, 2007.

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, Two High Ridge Road, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

No interferences or appeals are known to Appellants, Appellants' legal representative, or assignee that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims **50-77** are pending in the present application and are rejected.

Claims **50-77** are being appealed.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the Final Office Action mailed December 8, 2006, the rejections of which are being appealed herein.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the independent claims being appealed, and the dependent claims being specifically argued, are provided below. The summaries include sufficient information about the claimed subject matter so that an informed review of the Examiner's adverse determination of patentability can be made.

As required by 37 C.F.R. § 41.37(c)(1)(v), reference is made to the Specification and Drawings, as appropriate. Any such reference:

(i) is by way of example of the claimed subject matter only;

(ii) is to be considered as potentially useful in clarifying the particular subject matter of the particular independent claim being explained (and not other claims or "the invention" as a whole), unless explicitly stated otherwise; and

(iii) is not to be considered as broadening or narrowing the scope of any recited term from its meaning to one of ordinary skill in the art, unless explicitly stated otherwise.

Of the claims being appealed, claims **50, 71, 72 and 74** are independent, and dependent claims **57, 58, 64 and 73** are specifically argued.

1. Independent Claim 50

In accordance with one or more embodiments, a method comprises *generating an outcome represented by a plurality of symbols*. See, for example, Specification, pg. 14, lines 15-19; Figs. 9A, 9B.

The method further provides for *counting occurrences of at least one tracked symbol, thereby determining a number of occurrences of the at least one tracked symbol counted in accordance with an expiration condition*. See, for example, Specification, pg. 14, lines 20-23; pg. 17, lines 17-21; Figs. 9A, 9B.

The method further provides for *determining whether the number is at least a minimum number*. See, for example, Specification, pg. 15, lines 5-10; Figs. 9A, 9B.

The method further provides for *providing, if the number is at least a minimum number, a bonus payout based on the number of occurrences of the at least one tracked symbol* (See, for example, Specification, pg. 15, lines 5-10; Figs. 9A, 9B) *wherein the expiration condition defines at least one of (i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires* (See, for example, Specification, pg. 16, lines 10-13; Figs. 9A, 9B) *and (ii) a period of time, from a time at which an occurrence occurs, after which the occurrence expires* (See, for example, Specification, pg. 16, lines 9-10; Figs. 9A, 9B) *and further wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time*. See, for example, Specification, pg. 15, lines 18-20.

2. Independent Claim 71

In accordance with one or more embodiments, a method comprises *identifying at least one tracked symbol*. See, for example, Specification, pg. 5, lines 13-17.

The method further provides for *associating an expiration condition with each occurrence of the at least one tracked symbol wherein each occurrence of the at least one tracked symbol expires after its associated expiration condition has been satisfied* (See, for example, Specification, pg. 7, lines 17-21)*, such that a first occurrence of the at least one tracked symbol may expire at a first time while a second occurrence of the at least one tracked symbol may expire at a second time that is different from the first time*. See, for example, Specification, pg. 15, lines 18-20).

The method further provides for *determining a number of qualifying occurrences of the at least one tracked symbol*. See, for example, Specification, pg. 17, lines 17-21.

The method further provides for *determining whether the number is at least a minimum number*. See, for example, Specification, pg. 17, lines 17-21.

The method further provides for *providing, if the number is at least the minimum number, a bonus payout based upon the number of qualifying*

occurrences of the at least one tracked symbol, wherein the number equals the number of occurrences of the tracked symbol during play less the number of expired tracked symbols. See, for example, Specification, pg. 15, lines 20-22; Figs. 9A, 9B.

3. Independent Claim 72

In accordance with one or more embodiments, a method comprises *identifying at least one tracked symbol having an associated expiration condition wherein an occurrence of the at least one tracked symbol expires upon the associated expiration condition becoming satisfied*. See, for example, Specification, pg. 5, lines 13-17; pg. 7, lines 17-21; Figs. 9A, 9B.

The method further provides for *identifying a bonus value.* See, for example, Specification, pg. 15, lines 11-15.

The method further provides for *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence*. See, for example, Specification, pg. 14, lines 2-4; Figs. 9A, 9B.

The method further provides for *providing a bonus payout when the count value exceeds the bonus value*. See, for example, Specification, pg. 15, lines 5-10.

4. Independent Claim 74

In accordance with one or more embodiments, a gaming device comprises a processor and a memory coupled to the processor storing a program to control the operation of the processor wherein the processor is operative with the program to *generate an outcome represented by a plurality of symbols*. See, for example, Specification, pg. 14, lines 15-19; Figs. 9A, 9B.

The program includes further instructions executable on the processor that are operable to *count occurrences of at least one tracked symbol, thereby determining a number of occurrences of the at least one tracked*. See, for example, Specification, pg. 14, lines 20-23; pg. 17, lines 17-21; Figs. 9A, 9B.

The program includes further instructions executable on the processor that are operable to *determine whether the number is at least a minimum number*. See, for example, Specification, pg. 15, lines 5-10; Figs. 9A, 9B.

The program includes further instructions executable on the processor that are operable to *provide, if the number is at least a minimum number, a bonus payout based on the number of occurrences of the at least one tracked symbol* (See, for example, Specification, pg. 15, lines 5-10; Figs. 9A, 9B) *wherein the expiration condition defines at least one of (i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires* (See, for example, Specification, pg. 16, lines 10-13; Figs. 9A, 9B) *and (ii) a period of time, from a time at which an occurrence occurs, after which the occurrence expires* (See, for example, Specification, pg. 16, lines 9-10; Figs. 9A, 9B) *and further wherein the*

expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time. See, for example, Specification, pg. 15, lines 18-20.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims **50-54, 56-58, 60-62, 64-69 and 71-77** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Barrie (U.S. Patent No. 5,833,537).

Claim **70** is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Barrie.

ARGUMENTS

1. Form of Appeal Brief

In the arguments herein, limitations of the claims are indicated in *italics*, claim numbers are indicated in **bold**, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups of claims, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

In the arguments below, Appellants may refer to:

The Second Office Action, which was mailed on July 20, 2005 as part of Paper No./Mail Date 20050711;

The Final Office Action, which is the office action the rejections of which are being appealed herein, which was mailed on December 8, 2006 as part of Paper No./Mail Date 20061129; and

The Response to the Final Office Action, which was mailed by Appellants on April 13, 2007.

2. 35 U.S.C. §102(e) Rejections

Claims **50-54, 56-58, 60-62, 64-69 and 71-77** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Barrie (U.S. Patent No. 5,833,537).

Appellants traverse these rejections.

A reading of the rejections reveals that the Office has improperly interpreted the teachings and Barrie. As a result, the Office has failed to show how any claim is unpatentable in light of the cited reference.

The Examiner's Section 102(e) rejections based on the above grounds are argued separately for the following appealed claims and groups of appealed claims:

- Claims **50, 71 and 74**;
- Claim **57;**
- Claim **58**;
- Claim **64**;
- Claim **72**;
- Claim **73**.

2.1. Independent Claims **50, 71 and 74**

Appellants respectfully assert that the Examiner has failed to show how the limitations of claims **50, 71 and 74** are taught or suggested by Barrie. It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2

USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. Accordingly, the Section 102(e) rejection of claims **50, 71 and 74** are improper, and must be withdrawn.

2.1.1. Barrie neither teaches nor suggests:

- *determining a number of occurrences of the at least one tracked symbol;*
- *determining whether the number is at least a minimum number; and*
- *providing, if the number is at least a minimum number, a bonus payout.*

With reference to claims **50-53, 65-68 and 71-77**, the Office asserted that "Barrie teaches generating at least one outcome wherein each outcome includes a plurality of instances selected from a plurality of machine symbols appearing on a plurality of pay-lines (Figure 1 & Abstract). The set of machine symbols including a plurality of persistent (tracked) slot machine symbols (124a, 124b, 124c) wherein on the occurrence of a persistent symbol a running count is adjusted in a respective counting grid (142, 144, Figure 7) respectively. The symbols of Barrie further independently expire due to the passage of time and/or the playing a predetermined number of subsequent rounds (Abstract). Barrie additional teaches the awarding of a bonus payout as determined by the count present in the counting grid (Figure 5)." (Final Office Action, page 4).

Appellants respectfully assert that Barrie does not teach or suggest determining a number of occurrences of a tracked symbol, much less providing a payout if a minimum number of symbols is observed. At most, Barrie teaches that

a particular type of symbol may affect a payout, by affecting a magnitude of a multiplier applied to the payout.

For example, with respect to Fig. 4, Barrie describes that a multiplier symbol, if it occurs on a payline, changes the multiplier associated with the payline: "when [a multiplier symbol occurs in a symbol position of a payline] the multiplier in the payline which contains this position 118h (in this example, the bottom payline 412c[sic] is changed to show a new value. In one embodiment, the new value will be the sum of the previous value and the value of the multiplier symbol." (Col. 6, lines 5 – 10). However, there is no teaching or disclosure in Barrie that the occurrence of such a multiplier symbol in any manner causes a bonus payout to be provided, much less the particular embodiment of determining whether to provide a bonus payout claimed in claims **50, 71 and 74** (if the number of occurrences of a tracked symbol is at least a minimum number).

In Barrie, even though a multiplier symbol occurred, no payout is provided based on the occurrence of this symbol, unless and until a winning outcome is achieved on the payline associated with the symbol. In fact, Barrie explicitly teaches away from providing any payout based solely on the occurrence (or number of occurrences) of a multiplier or other persistence symbol:

> *"Preferably, the symbols can affect the amount of a pay out, although preferable they do not affect whether or not a game has a winning result."* Col. 2, lines 27 – 29; and
>
> *"persistence symbols are believed to add to the action or play of the game, but do not, in themselves, occasion a pay out."* Col. 9, lines 1 – 2.

Thus, even if some number of multiplier or other persistence symbols were to be obtained by the player in Barrie, the mere occurrence of these symbols do not occasion a payout, as is recited in claims **50, 71 and 74**. Rather, the occurrence of a multiplier or other persistence symbol in Barrie merely "affects the amount of the price or award, for at least some winning game outcomes." (Col. 2, lines 13 – 15). In Appellants' claimed embodiments, once a minimum number of occurrences of at least one tracked symbol is determined, a bonus payout is provided.

In the Response to Amendment section of the Final Office Action (page 8), The Examiner asserted the following:

> 24. In regards to claims 50, 71, and 74;
> - *Determining a number of occurrences of the at least one tracked symbol*
> - *Determining whether the number is at least a minimum number;*
> - *Providing, if the number is at least a minimum number, a bonus payout.*
>
> 25. If you observe Fig. 5, Barrie's invention tracks a symbol at #516, checks if it reaches a certain number at #518, and if it is reached it awards a bonus at #520.

Appellants respectfully assert that the Examiner is in error when interpreting and applying the teachings of Barrie. With reference to the Examiner's citation, Barrie discloses at col. 6, lines 27-42 (describing Fig. 5):

> FIG. 5 depicts a procedure which may be used in connection with an electronic keno game. In the embodiment of FIG. 5, after the user places a wager 512, the game selects up to 20 numbers, e.g., of a total of 80 potential numbers 514. In the embodiment of FIG. 5, a persistent symbol such as a check mark is positioned in each number

> location selected by the user in the previous step 516. The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks 518, and, if so, a special prize 520, based on the presence of the persistent symbols is ordered. Otherwise, the system randomly deletes a number of the persistent symbols 522. In one embodiment, the number which is deleted on each turn is a constant. In another embodiment, the deleted number may vary from round to round. Preferably, the number deleted is, at least on average, low enough to permit a determined player to eventually win the prize 520, but large enough to require players, in most cases, to play a relatively large number of rounds in order to have a reasonable chance of winning the prize 520. In one embodiment, two to three symbols are deleted each round. As before, the device may be provided with animation 524, in conjunction with the persistence features of the game.

Appellants note that this description contains numerous logical inconsistencies that render a clear understanding of the teaching unobtainable. Put, simply, the disclosure is both unclear and logically inconsistent. In addition, the Examiner's apparent perception of the teachings of Barrie, while perhaps superficially plausible, suffers of necessity from the underlying defects in the disclosure of Barrie.

Appellants proceed by providing a brief explanation of the defects of Barrie. The method steps of Fig. 5 are annotated as follows: "wager" (step 512), "select 20 numbers" (step 514), and "add persistence symbols to selected numbers" (step 516). It is therefore evident that the selected numbers of step 516 are the 20 numbers selected in step 514. Further support for this observation is provided in the citation above wherein it is stated that "the game selects up to 20 numbers, e.g., of a total of 80 potential numbers 514". It is therefore evident that the selected 20 numbers are selected by the game.

A problem therefore arises when Barrie discloses that "In the embodiment of FIG. 5, a persistent symbol such as a check mark is positioned in each number location **selected by the user in the previous step 516**." (emphasis added). The number locations, more accurately "the numbers", selected in the immediately preceding step are not selected by the user, but rather by the game. The only other preceding step, step 512, contains no annotation indicating any selection of numbers by the player. It is therefore not clear whether the check marks are positioned at the number locations selected by the game or at some other undefined positions corresponding to numbers selected by the player. Assuming, arguendo, that the check marks are related to some selection by the user/player, it is clearly stated that the check mark **is** the persistent symbol and it is positioned in a number location selected by the user. Therefore, the location of each check mark is the symbol position.

All of this leads to the confusing disclosure that "The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks 518". Of the two possible interpretations of this teaching, neither appears logical. As noted above, the symbol positions are defined to be some manner of position in which a check mark (the symbol) is positioned. In short, no check mark, no symbol position. Therefore, by definition, at all times, each and every symbol position is filled by a check mark. As the number of check marks is greatest (in fact it is at a maximum) prior to the subsequent deletion of any check marks, a special prize would be awarded at the outset of any game, regardless of any possible set minimum number of check marks. And yet, Barrie clearly contemplates, as noted in the recitation above, that the user does not win the prize every game. It is therefore clear that,

contrary to the clear teachings of Barrie, the disclosed symbol positions differ from the positions of the check marks.

If one assumes, alternatively, that the symbol positions refer to all of the *potential* symbol positions on "the simulated keno card" (nowhere described or illustrated), other problems of interpretation arise. Consider once again that Barrie states that "The system then determines whether a minimum number, such as all of the symbol positions on the simulated keno card, have been filled with check marks 518". As written, the exemplary "minimum number" is "all of the symbol positions", presumably the total number of such positions, of the keno card. However, this number cannot serve as a minimum as the number of check marks is presumably always less than the "total of 80 potential numbers 514". In short, if 80 keno card positions is the minimum number of positions that must be filled by user selected check mark positions in order to win the prize, the player can only win if he/she selects every position. However, were this allowed, the player would win every time at the outset when the number of check marks equals the minimum, 80. Such is not the case.

With an understanding of these various internal inconsistencies, Appellants respectfully turn to the Examiner's interpretation of the teachings of Barrie. As noted above, the Examiner asserted that "If you observe Fig. 5, Barrie's invention tracks a symbol at #516, checks if it reaches a certain number at #518, and if it is reached it awards a bonus at #520."

Appellants respectfully assert that, contrary to the Examiner's assertion, Barrie does not teach *determining a number of occurrences of the at least one tracked symbol, determining whether the number is at least a minimum number,*

and providing, if the number is at least a minimum number, a bonus payout as claimed.

When the Examiner's assertions are aligned with the claimed elements and interpreted in light of the discussion above, it is evident that Barrie fails to teach or otherwise suggest the elements of claim **50**. The Examiner appears to equate the "symbol at #516" with the claimed "at least one tracked symbol". Note that claim **50** further recites determining a number of occurrences of the tracked symbol and determining if such a number is equivalent to a minimum number. The Examiner continues by asserting that Barrie checks if it (the tracked symbol) reaches a certain number at #518. Presumably, the Examiner is inferring that Barrie keeps track of the number of check marks and checks to see if this number "reaches a certain number #518". However, as described above, there is no reasonable and logically consistent interpretation of Barrie that involves providing a bonus payout when the number of check marks reaches a minimum. As noted above, regardless of the conflicting assumptions under which one proceeds to interpret the teachings of Barrie, it is clear that the number of check marks is at a maximum at the commencement of the game, that the number of check marks decreases over time, and that it is some unspecified attribute related to the check marks that triggers a payout when it equals some minimum number. As noted, because the number of check marks cannot *decrease* to reach such a minimum, Barrie clearly involves some aspect or attribute of the check marks separate from the check marks, and not identified or disclosed, that causes the bonus prize to be paid.

While the Appellants are unable to propose even a guess as to what this attribute might be, it is clear that, contrary to the Examiner's assertions, Barrie fails to teach *determining a number of occurrences of the at least one tracked symbol, determining whether the number is at least a minimum number, and providing, if*

the number is at least a minimum number, a bonus payout as recited in claim **50**. For all of these reasons, the rejection of claim **50** must be withdrawn. As both of claims **71 and 74** recite similar language, the rejections of claims **71 and 74** must likewise be withdrawn.

It is further respectfully submitted that the rejections of each of dependent claims **51 – 55, 56–69, 73, and 75 – 77** must be withdrawn at least for the same reasons as claims **50, 71, 72 and 74** (i.e., because each of these independent claims include one of the sets of features discussed above).

2.2. Claim 57

Appellants respectfully assert that claim **57** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests:

- *wherein determining a bonus payout further includes determining the bonus payout based on a number of plays of a slot machine.*

With regards to claim **57**, the Office asserted that "the claimed determination of a bonus payout based on the number of plays and/or the a duration of time is considered taught above by Barrie through the requirement of completing a grid prior to the expiration of at least one symbol presently held in the grid." (Final Office Action, page 5).

Appellants take no stand on the accuracy of the above assertion except to note that Barrie nowhere recites "completing a grid". In fact, the only mention of a "grid" in Barrie is in Fig. 5 whereat, at step 518, there is illustrated "Grid filled?".

The description of this step at col. 6, lines 36- 38, reproduced above, likewise makes no reference to completing a grid.

However, even assuming, arguendo, that Barrie teaches a requirement of completing a grid prior to an expiration of at least one symbol (presumably, though not so stated, related to determining a payout), anything based upon a completion of a grid of Barrie is not based upon *a number of plays of a slot machine* as recited in claim **57**. Specifically, "completing a grid" does not define *a number of plays of a slot machine* and, hence, any determination based upon completing a grid is, by necessity, not based upon *a number of plays of a slot machine* as recited in claim **57**. For example, if one assumes that, according to Barrie, completing a grid results in a determination of a bonus payout (which, again, is not disclosed by Barrie), there is most emphatically no teaching in Barrie that the payout would be different if the grid was filled in five plays versus filling the grid in seven plays. Specifically, even in such a scenario, the bonus payout would not be determined *based on a number of plays of a slot machine* as claimed.

For these additional reasons, the rejection of claim **57** must be withdrawn.

2.3. Claim **58**

Appellants respectfully assert that claim **58** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests:

- *wherein determining a bonus payout further includes determining the bonus payout based on a duration of time.*

With regards to claims **58**, the Office asserted that "the claimed determination of a bonus payout based on the number of plays and/or the a duration of time is considered taught above by Barrie through the requirement of completing a grid prior to the expiration of at least one symbol presently held in the grid." (Final Office Action, page 5).

Appellants take no stand on the accuracy of the above assertion except to note that Barrie nowhere recites "completing a grid". In fact, the only mention of a "grid" in Barrie is in Fig. 5 whereat, at step 518, there is illustrated "Grid filled?". The description of this step at col. 6, lines 36- 38, reproduced above, likewise makes no reference to completing a grid.

However, even assuming, arguendo, that Barrie teaches a requirement of completing a grid prior to an expiration of at least one symbol (presumably, though not so stated, related to determining a payout), anything based upon a completion of a grid of Barrie is not based *on a duration of time* as recited in claim **58**. Specifically, "completing a grid" does not define *a duration of time* and, hence, any determination based upon completing a grid is, by necessity, not based upon *a duration of time* as recited in claim **58**. For example, if one assumes that, according to Barrie, completing a grid results in a determination of a bonus payout (which, again, is not disclosed by Barrie), there is most emphatically no teaching in Barrie that the payout would be different if the grid was filled in five minutes versus filling the grid in seven minutes. Specifically, even in such a scenario, the bonus payout would not be determined based *on a duration of time* as claimed.

For these additional reasons, the rejection of claim **58** must be withdrawn.

2.4. Claim **64**

Appellants respectfully assert that claim **64** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests:

- *determining a payout for expired occurrences of the at least one tracked symbol.*

With regards to claims **64**, the Office asserted that "Barrie teaches associating a zero payout for those symbols which have expired (Col 8:1-10 & Abstract) and as such encompasses the claimed 'determining a payout for expired occurrences of the at least one tracked symbol'." (Final Office Action, page 6).

Appellants note that, at Col 8:1-10, Barrie discloses:

> Various schemes can be provided for awarding prizes based on the markers on the bingo cards 714. In one embodiment, the game pays various amounts for blackout (all positions of a card bearing markers), four corners, outer ring, X, any diagonal or any row. Although it is possible to use combinatoric/statistical analysis to determine the game parameters, it may be more straightforward to simulate a large number of games at different pay amounts (and/or other game parameters) in order to fine-tune the percentages to achieve the desired game operation.

As is evident, contrary to the Office's assertion, Barrie nowhere discloses, at the asserted citation, anything remotely related to *determining a payout for expired occurrences of the at least one tracked symbol.* Appellants further affirmatively assert that Barrie does not elsewhere disclose this element of claim **64**. For this additional reason, Appellants respectfully assert that the rejection of claim **64** must be withdrawn.

2.5. Independent Claim **72**

Appellants respectfully assert that independent claim **72** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests:

- *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence.*

Appellants respectfully assert that Barrie does not teach or suggest monitoring a count value of occurrences of tracked symbols, much less providing a payout if a minimum number of such symbols occur. At most, Barrie teaches that a particular type of symbol may affect a payout, by affecting a magnitude of a multiplier applied to the payout.

In the Response to Amendment section of the Final Office Action (page 9), the following was asserted:

> 29. Barrie's invention states in the description of Fig. 3 (Col 5:27-52), incrementing the count, decrementing the count and expiration limits, combined with the description of Fig. 5 (Col 6:27-50), covers this argument.

Appellants respectfully assert that Barrie does not teach, at the Examiner's citation or elsewhere, incrementing a count value of the occurrences of a tracked

symbol and decreasing the count value when the occurrence of the tracked value expires.

Barrie teaches, at the Examiner's citation to Col. 5:27-52:

> As depicted in FIG. 3, the game is initiated when a player places a wager 312 and initiates a spin 314 (or, in the case of keno game, a number draw; in the case of a card game, a deal, etc.). After the spin, it is determined whether an add event has occurred 316. In the embodiment of FIG. 1, an add event is the appearance of a red ball. A number of types of add events can be used for the present invention. For example, a persistent symbol can be added in response to the passage of a certain amount of time or play of a certain number of rounds, without the appearance of the persistent symbol in a given position. Persistent symbols can be randomly generated, e.g., by events output from a random number generator, and the like. If an add event has occurred, the persistent indicator is shown on the play field 318. The system also determines whether a delete event has occurred 320. In the embodiment of FIG. 1, a delete event is the appearance of a black ball in a location which bears a persistent symbol. Other types of delete events can be used, such as the passage of a certain amount of time or play of a certain number of games, a period of time without any game play, a new player initiating play on the gaming terminal (as might be indicated by a player card inserted in the card acceptor), and the like. If desired, the frequency of adding and/or deleting events may be dynamic, such as changing the frequency at various times of day, or in other fashions, e.g., for marketing purposes and the like.

As is evident, Barrie teaches adding a persistent symbol in response to an add event and deleting a persistent symbol in response to a delete event. There is no teaching of, and indeed no need for, a counter of any sort tracking the occurrences and expirations of a tracked symbol as claimed. Appellants therefore respectfully assert that the Examiner is in error when asserting that Barrie "state in the description … incrementing the count, decrementing the count and expiration

limits". Further, as there is no teaching of the claimed count value, the Examiner is further in error when asserting that a combination of the above citation with that of Col. 6:27-50 "covers this argument".

Appellants do note that Barrie teaches, at col. 5, lines 8-18:

> In an embodiment in which it is desired to retain a persistent position for no more than five successive rounds, the system can be configured such that a value of zero in a memory location means that no persistent symbol is to be displayed in the corresponding play field position, and such that a value of five is stored in the corresponding memory location whenever a persistent symbol is first positioned at a location of the play field. Thereafter, each time a round is played, the values of all non-zero, positive memory locations in the array 234 may be decremented by one. In this fashion, a persistent symbol will be removed after five games.

It is evident from this passage that Barrie teaches incrementing and decrementing a value in memory corresponding to a persistence value of a persistent symbol. However, this value is not a count of the occurrences of a tracked symbol, nor is it *decremented when an occurrence of the at least one tracked symbol expires* as claimed. Rather, it is by decrementing the value in memory that a tracked symbol of Barrie ceases to persist and, hence, expires.

It is therefore evident that Barrie fails to teach or otherwise suggest *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence* as recited in claim **72**. For this reason alone, the rejection of claim **72** must be withdrawn.

2.6. Claim 73

Appellants respectfully assert that claim **73** recites numerous limitations that are not taught or suggested by Barrie. Specifically, Barrie neither teaches nor suggests:

- *terminating the determining of the count value upon termination of the session of play by the player.*

Appellants note that the Office provides no citation to Barrie supporting such a teaching. Appellants further affirmatively that Barrie nowhere teaches *terminating the determining of the count value upon termination of the session of play by the player* as recited in claim **73**. For this additional reason, the rejection of claim **73** must be withdrawn.

3. 35 U.S.C. §103(a) Rejections

Claim **70** stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Barrie (US 5,833,5372).

It stands asserted that "Barrie teaches providing a payout based on the results of a first game, the counting of predetermined symbols, and embodiments which further include the use of card games (Col 3:2-5) as taught above however Barrie is silent regarding the use of face value cards for the purpose tracked symbols. As no stated problem is solved or unexpected result obtained in the utilization of card face values in the place of the symbols of Barrie this feature is deemed to be a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilization of card face values

in the place of the symbols of Barrie in order to allow the persistent symbol feature depiction in order to correspond the persistent symbols to a desired game theme." (Final Office Action, page 7, sec. 22).

As is clearly stated at MPEP §2143 "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** (emphasis added).

Appellants respectfully assert that the Examiner has failed to show how the limitations of claim **70** are taught or suggested by Barrie. Accordingly, the Section 103(a) rejection of claim **70** is improper and must be withdrawn.

Appellants respectfully assert that Barrie, fails to teach or suggest the feature of providing a bonus payout based on a number of occurrences of at least one tracked if the number of occurrences is at least a minimum number as recited in claim **50** and discussed in detail above in section 2.1. As claim **70** depends upon claim **50**, and incorporate all of the elements and limitations of claim **50**, the rejection of claim **70** must likewise be withdrawn.

In addition, Appellants note that claim **70** recites *wherein the at least one tracked symbol comprises a function of the face value of cards dealt in a hand.* Assuming, arguendo, that it would have been obvious to utilize card face values in

the place of symbols, such is not recited in claim **70**. Rather, claim **70** recites that *the at least one tracked symbol comprises a function of the face value of cards* (emphasis added). Appellants affirmatively assert that Barrie does not teach or disclose this element of claim **70** while noting that there is nowhere addressed in the Final Office Action this element of claim **70**. For all of these additional reasons, the rejection of claim **70** must be withdrawn.

CONCLUSION

Thus, the Examiner's rejections of the pending claims are improper at least because the Examiner has not provided a proper legal basis for rejecting any claim. Therefore, Appellants respectfully request that the Examiner's rejections be withdrawn.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Jeffrey R. Ambroziak, at telephone number 203-461-7317 or via electronic mail at jambroziak@walkerdigital.com.

Appellants believe that this Appeal Brief is filed within one month of the statutory time within which to respond. Accordingly, filed herewith is a petition for a one month extension of time as well as the attendant fees. However, if an additional fee should be due, please charge such fees to our Deposit Account No. 50-0271.

September 10, 2007
Date

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APPENDIX A - CLAIMS INVOLVED IN THE APPEAL

50. A method comprising:

generating an outcome represented by a plurality of symbols;

counting occurrences of at least one tracked symbol, thereby determining a number of occurrences of the at least one tracked symbol counted in accordance with an expiration condition;

determining whether the number is at least a minimum number; and

providing, if the number is at least a minimum number, a bonus payout based on the number of occurrences of the at least one tracked symbol,

wherein the expiration condition defines at least one of

(i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires and

(ii) a period of time, from a time at which an occurrence occurs, after which the occurrence expires, and further

wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time.

51. The method of claim 50 wherein counting occurrences of at least one tracked symbol includes incrementing a count value by an integer value.

52. The method of claim 50 wherein the expiration condition includes a number of plays after which an occurrence of the at least one tracked symbol expires, and

wherein the method further includes determining an expiration of an occurrence of the at least one tracked symbol based on the expiration condition.

53. The method of claim 50 wherein the expiration condition includes a time after which an occurrence of the at least one tracked symbol expires, and

wherein the method further includes determining an expiration of an occurrence of the at least one tracked symbol based on the expiration condition.

54. The method of claim 50 wherein counting occurrences of at least one tracked symbol is performed only if a payout amount for the outcome is less than a predefined amount.

55. The method of claim 51 further including storing the count value on a player tracking card, and wherein the count value includes status data related to an expiration criterion of each occurrence of the at least one tracked symbol.

56. The method of claim 51 further including storing the count value at a slot server, and wherein the count value includes status data related to an expiration criterion of each occurrence of the at least one tracked symbol.

57. The method of claim 50 wherein determining a bonus payout further includes determining the bonus payout based on a number of plays of a slot machine.

58. The method of claim 50 wherein determining a bonus payout further includes determining the bonus payout based on a duration of time.

59. The method of claim 51 wherein the count value represents occurrences of the at least one tracked symbol generated by a second slot machine.

60. The method of claim 50 further including receiving a wager, and

wherein determining a bonus payout further includes determining the bonus payout based on the wager.

61. The method of claim 51 wherein the at least one tracked symbol includes at least one bonus symbol which contributes to the count value and at least one offsetting symbol, and

wherein counting occurrences of at least one tracked symbol further includes decrementing the count value with each occurrence of the at least one offsetting symbol.

62. The method of claim 50 further including:

determining a payout, and

wherein determining a bonus payout comprises determining a multiplier to be applied to the payout.

63. The method of claim 50 wherein determining a bonus payout includes determining points for a slot play reward system.

64. The method of claim 63 further including determining a payout for expired occurrences of the at least one tracked symbol.

65. The method of claim 50 wherein generating an outcome is performed by a gaming device.

66. The method of claim 65 wherein the gaming device includes a reel slot machine and the symbols include reel symbols.

67. The method of claim 66 wherein the reel slot machine includes a symbol display window and a payout line visible within the symbol display window; and

wherein counting occurrences of at least one tracked symbol includes selecting at least one tracked symbol from among all symbols displayed in the symbol display window.

68. The method of claim 66 wherein counting occurrences of at least one tracked symbol includes selecting the at least one tracked symbol from among symbols on a specified reel of the reel slot machine.

69. The method of claim 65 wherein the gaming device includes video poker machine and the symbols include playing card attributes.

70. The method of claim 69 wherein the at least one tracked symbol comprises a function of the face value of cards dealt in a hand.

71. A method comprising:

identifying at least one tracked symbol;

associating an expiration condition with each occurrence of the at least one tracked symbol wherein each occurrence of the at least one tracked symbol expires after its associated expiration condition has been satisfied, such that a first occurrence of the at least one tracked symbol may expire at a first time while a second occurrence of the at least one tracked symbol may expire at a second time that is different from the first time;

determining a number of qualifying occurrences of the at least one tracked symbol;

determining whether the number is at least a minimum number; and

providing, if the number is at least the minimum number, a bonus payout based upon the number of qualifying occurrences of the at least one tracked symbol, wherein the number equals the number of occurrences of the tracked symbol during play less the number of expired tracked symbols.

72. A method comprising:

identifying at least one tracked symbol having an associated expiration condition wherein an occurrence of the at least one tracked symbol expires upon the associated expiration condition becoming satisfied;

identifying a bonus value;

determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence; and

providing a bonus payout when the count value exceeds the bonus value.

73. The method of claim 72 wherein determining a count value further includes:

initializing the count value upon initiation of a session of play by a player; and

terminating the determining of the count value upon termination of the session of play by the player.

74. A gaming device comprising:

a processor;

a memory coupled to the processor storing a program to control the operation of the processor;

the processor operative with the program to:

generate an outcome represented by a plurality of symbols;

count occurrences of at least one tracked symbol, thereby determining a number of occurrences of the at least one tracked symbol; and

determine whether the number is at least a minimum number; and

provide, if the number is at least a minimum number, a bonus payout based on a number of occurrences of the at least one tracked symbol counted in accordance with an expiration condition,

wherein the expiration condition defines at least one of

(i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires and

(ii) a period of time, from a time at which an occurrence occurs, after which the occurrence expires, and further

wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time.

75. The gaming device of claim 74 wherein the processor counts occurrences of the at least one tracked symbol by incrementing a count value by an integer value.

76. The gaming device of claim 74 wherein the expiration condition represents a number of plays after which an occurrence of the at least one tracked symbol

expires and the processor is further operative with the program to determine an expiration of an occurrence of the at least one tracked symbol based on the expiration condition.

77. The gaming device of claim 74 wherein the expiration condition represents a time after which an occurrence of the at least one tracked symbol expires and the processor is further operative with the program to determine an expiration of an occurrence of the at least one tracked symbol based on the expiration condition.

APPENDIX B – EVIDENCE

<NONE>

APPENDIX C – RELATED PROCEEDINGS

<NONE>